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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|------------------------|---------------------|------------------|
| 10/661,508 | 09/15/2003 | Brandt Gerard Cordelli | JCORD-1 | 7398 |
| 23599 | 7590 | 06/24/2009 | EXAMINER | |
| MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201 | | | EVANS, KIMBERLY L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3629 | |
| | | | NOTIFICATION DATE | DELIVERY MODE |
| | | | 06/24/2009 | ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@mwzb.com

| | | |
|------------------------------|------------------------|-------------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/661,508 | CORDELLI, BRANDT GERARD |
| | Examiner | Art Unit |
| | KIMBERLY EVANS | 3629 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 03 April 2009.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1,2,5-8,11-20,33,34 and 39-42 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1, 2, 5-8, 11-20, 33, 34, and 39-42 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____.
 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) Notice of Informal Patent Application
 6) Other: _____.

DETAILED ACTION

Response to Amendments

1. This office action in response to the amendments filed April 3, 2009.
2. Claims 1, 2, 5-8, 11, 12, 33 and 34 have been amended. Claims 3, 4, 9, 10, 21-32, and 35-38 have been cancelled. Claims 39-42 are new.
3. Claims 1, 2, 5-8, 11-20, 33, 34, and 39-42 are currently pending and have been examined.
4. The rejections of claims 1, 2, 5-8, 11, 12, 33 and 34 have been updated to reflect the amendments.
5. The Examiner has carefully reviewed the Applicant's response and has determined that the rejection stands and is resubmitted below addressing the claims as modified by said amendments.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
 - (a) Determining the scope and contents of the prior art.
 - (b) Ascertaining the differences between the prior art and the claims at issue.
 - (c) Resolving the level of ordinary skill in the pertinent art.
 - (d) Considering objective evidence present in the application indicating obviousness or nonobviousness.
8. Claims 1, 2, 5-8, 11, 12, 17, 18, 33, 34, 39, and 40 are rejected under 35 USC 103(a) as being unpatentable over Borghesi US Patent No 5,950,169, in view of Prager US Patent No 5,94,670.
9. With respect to Claims 1 and 2,
Borghesi discloses the following limitations,
 - *a tangible medium computer particularly configured with:*
 - *particular data setting forth a multiplicity of categories of circumstances relevant to analyzing the claim; which either apply or do not apply to the claim, and* (see at least Abstract: "...The method includes the steps of transmitting a claim assignment from an insurance office computer to a mailbox in a communications server, retrieving the assignment at a remote computer and generating an insurance claim datafile containing all data pertinent to an insurance claim and allowing for bidirectional transmission of the datafile over a wide area network...."; column 4, lines 29-34: "...Each workfile represents one particular claim. A workfile can have a number of entries which would depend on a particular application...")
 - *computer-executable instructions particular for determining from the number of categories found to apply* (see at least column 9, lines 8-13: "...the user is provided with the overlapping tab format, visible to a user as overlapping folders, or tab icons,

summarizing categories of information applicable to the workfile..") *whether the claim should be referred to a higher review level* (see at least column 16, lines 57-60: "... If the body shop determined 418 that the repairs exceed the appraiser/adjuster's estimate, then the body shop performs 419 its own computerized estimate, takes electronic images, of the car, and contacts the appraiser/adjuster...")

- *computer-executable instructions for display of the results of applicable categories and the result of the referral determination* (see at least Figure 6, column 7, lines 54-63: "...As illustrated in FIG. 6, a preferred graphic user interface 82 for use with the method and system of the present invention allows an authorized user to control claims processing workflow for one or more insurance datafiles. The graphic user interface not only permits a user to enter and retrieve information from a datafile, but also permits the user to execute tasks involved in claims processing such as manipulating a plurality of claim datafiles, opening a specific claim datafile and working on estimate calculations or correspondence related to the open file....")

Borghesi discloses all of the above limitations, Borghesi does not distinctly disclose the following limitations, but Prager however as shown discloses,

- *wherein the computer-executable instructions include programmed weightings of the applicable categories used for making the determination and a programmed threshold of the sum of weightings of the total categories or a sub-set of categories which determines the referral result, and* (column 3, lines 15-20: "...a system and method that categorizes the documents into both categories from an originally-defined set, and into virtual mixed categories constructed by making weighted means of pairs of original categories, and determining what values of the weights give the mixed categories the best matches...."; column 2, lines 33-41: "...systems usually employ one of the following techniques for purposes of committing category assignments to the document: 1) the top category is selected, 2) the top m categories are selected, for some predefined constant m, 3) all

categories which have a score greater than a threshold t are selected, and 4) the top category plus any categories which have a score greater than a threshold t are selected...”)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the system and method for managing insurance claim processing of Borghesi and the system and method for categorizing objects in combined categories of Prager because it is an efficient means for categorizing documents into both categories from an originally-defined set, and into virtual mixed categories via weighted means of pairs and determining what values of the weights give the mixed categories the best matches.

10. With respect to Claims 5 and 6,

Borghesi and Prager disclose all of the above limitations, Borghesi further discloses,

- *computer-executable instructions for determining, from the number of categories found to apply, whether the claim should be automatically referred to a higher review level without further analysis or referred to a higher review level with qualification of an additional analysis.* (see at least Figure 22, column 16, lines 57-60: “...If the body shop determined 418 that the repairs exceed the appraiser/adjuster's estimate, then the body shop performs 419 its own computerized estimate, takes electronic images, of the car, and contacts the appraiser/adjuster. The body shop performs 420 an Estimate Requires Supplements procedure as shown in FIG. 22...”)

11. With respect to Claims 7 and 8,

Borghesi and Prager disclose all of the above limitations, Prager further discloses,

- *computer is further configured to display the results of applicable categories so that multiple categories are displayed in a primarily prominent portion of the display and other categories are displayed in a secondarily prominent portion, the determination of referral being made*

from the categories in both such portions.(see at least column 9, lines 28-31: "...In step 550, results table 250 is sorted in order of decreasing score (field 253), and made available for display, inspection or further processing, as desired. The sorted results table is usually called a hit-list...")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the system and method for managing insurance claim processing of Borghesi and the system and method for categorizing objects in combined categories of Prager because it is an efficient means for displaying the sorted results based upon the weighted categories.

12. With respect to Claims 11 and 12,

Borghesi and Prager disclose all of the above limitations, Borghesi further discloses,

- *wherein the primarily prominent portion contains five categories.*(see at least Figure 6, column 1 lines : "...As shown in FIG. 6, the party information frame includes name, address and driver information on the vehicle owner, lien holder and/or the insured. The frame for statements includes information on the party making the statement, the type of statement, and the statement itself. Loss information includes type of loss, relationship between vehicle owner and claimant, and specifics about the time and nature of the loss itself. Repair site information includes specifics on the repair site such as location and state or federal licensing, as well as repair agreement terms and amounts. The categories of information just enumerated are enterable by the user using the graphic user interface in combination with input devices such as a keyboard, pointing devices such as a mouse or pen, and software based interface logic...")

13. With respect to Claims 17 and 18,

Borghesi and Prager disclose all of the above limitations, Borghesi further discloses,

- *wherein at least one category also contains associated with it one or more selectable data entries which relate to bases for finding the category applicable.* (see at least column 9, lines 8-12: "...Once a particular workfile in the in process box has been opened, the user is provided with the overlapping tab format, visible to a user as overlapping folders, or tab icons, summarizing categories of information applicable to the workfile...")

14. With respect to Claims 33 and 34,

Borghesi and Prager disclose all of the above limitations, Borghesi further discloses,

- *wherein the computer includes at least one data entry for information identifying the claim.*(see at least column 7, lines 24-28: "...On each computer in the network 72, a user views datafiles and other insurance claim processing information through a monitor and can enter and extract data via a keyboard, computer mouse, or pen attached to the computer...")

15. With respect to Claims 39 and 40,

Borghesi and Prager disclose all of the above limitations, Prager further discloses,

- *which further includes computer-executable instructions for changing the programmed weightings applicable to each category based on the previous data indicating that particular categories deserve more or less weight in making the determination.*(see at least : "...the top category plus any categories which have a score greater than a threshold t are selected...")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the system and method for managing insurance claim processing of Borghesi and the system and method for categorizing objects in combined categories of Prager because weighted categorization is an efficient means for monitoring claim data while minimizing processing time.

16. Claims 13-16, 19, 20, 41, and 42 are rejected under 35 USC 103(a) as being unpatentable over Borghesi US Patent No 5,950,169, in view of Weidner et al., US Patent Application Publication No US 2003/0009359 A1.

17. With respect to Claims 13 -16,

Borghesi and Prager disclose all of the above limitations, Borghesi and Prager does not distinctly disclose the following limitations, but Weidner however as shown discloses,

- *wherein the five categories in the primarily prominent portion are: 1) Preliminary Analysis Suggests Denial; 2) Mixed Suit - Covered and/or Potentially Covered with Uncovered Claims; 3) Key Policyholder Counsel Tenders Claim for Defense or Independent/Claims Counsel Involved; 4) Misrepresentation or Omission in Application and/or Pre-existing Loss Suspected; and one of the following: 5) Umbrella/Excess Coverage by Company, 6) Defense Tendered by Other than Named Insured, 7) Latent and/or Continuous and Progressive Injury or Damage, 8) Other Carriers Involved, or 9) Target Claims/Damages Alleged.(see at least Figure 3, paragraph 29: "...the insured (100) pays annual premiums in exchange for a claims paid insurance policy, which provides defense and indemnity coverage..")*
- *wherein the secondarily prominent portion contains the other categories 5) to 9) not on the primarily prominent portion plus the following categories: 10) Internet-Related Liability Issues, 11) Potential Personal Injury or Advertising Injury, 12) Insolvent Insurer and/or Guaranty Fund Involved or On Notice, 13) SIR of \$100,000 or More, and 14) Employment-Related Claims.*

Borghesi discloses summarizing categories of information applicable to a workfile as it relates to managing and processing insurance claims via a graphical user interface. Prager discloses a method for categorizing objects in combined categories and while Weidner does not specifically disclose "the five categories in the primarily prominent portion", Weidner does disclose a method for offering property and casualty liability claims paid coverage provided by captive programs including an interindemnity trust. It further discloses underwriting techniques based on policyholder characteristics and a classification plan. Wiedner discloses a claims-paid insurance policy to align the incentives of the covered entity, the risk-taker and the injured person in a formula that benefits all parties to include traditional coverages in exchange for defense of claims

and for an agreement to pay any claims for which the member might become liable. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the system and method for managing insurance claim processing of Borghesi, the weighted method for categorizing objects of Prager and the property/casualty insurance techniques of Weidner because it is an efficient means for providing a claims paid insurance product under applicable insurance laws. Furthermore, Claims 13-16 refer to non-functional descriptive material, "categories" and thus is not given patentable weight because applicant fails to disclose the steps involved in using the features above. Claims 13-16 recite a mere arrangement of data (categories) on the computer display.

18. With respect to Claims 19 and 20,

Borghesi, Prager and Weidner disclose all of the above limitations, Borghesi further discloses,

- *wherein each category also contains associated with it one or more selectable data entries which relate to bases for finding the category applicable.* (see at least column 9, lines 12-17: "...the section tabs 102 may include text and graphics designations for subjects such as administrative information, vehicle data, total loss information, events, estimates, totals, notes, correspondence, salvage, and rates...")

19. With respect to Claims 41 and 42,

Borghesi, Prager and Weidner disclose all of the above limitations, Prager further discloses,

- *wherein the programmed weightings for the categories in the primarily prominent portion are higher than the programmed weightings for the categories in the secondarily prominent portion.*(see at least : "...the top m categories are selected, for some predefined constant m...")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the system and method for managing insurance claim processing of Borghesi and the property/casualty insurance techniques of Weidner with the method for categorizing objects of

Prager because it is an efficient means for categorizing documents via weighted means of pairs of categories.

Response to Arguments

20. Applicant's arguments received on April 3, 2009 have been fully considered but they are moot in view of the new ground(s) of rejection.
21. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Kimberly L. Evans** whose telephone number is **571.270.3929**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **John Weiss** can be reached at **571.272.6812**.
22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free). Any response to this action should be mailed to: **Commissioner of Patents and Trademarks**, P.O. Box 1450, Alexandria, VA 22313-1450 or faxed to **571-273-8300**. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**: Randolph Building 401 Dulany Street, Alexandria, VA 22314.

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/JOHN G. WEISS/

Supervisory Patent Examiner, Art Unit 3629